

Rejection of Claims 14-21 and 42 Under 35 U.S.C. § 112, 2nd

Claim 14 is allegedly unclear for failing to articulate the connection between the method step and the preamble. Claim 14 has been amended to articulate the connection, thus obviating the rejection.

Claim 17 was rejected as the phrase "part of human wild-type p53 protein" was unclear as to its metes and bounds. This rejection is respectfully traversed.

Claim 17 recites a polypeptide. A polypeptide by definition does not include within its scope a single amino acid, as the Office Action speculated "a part" could include. A polypeptide is defined as many amino acids bonded together or an organic compound consisting of three or more amino acids. See www.ntri.tamuk.edu/cell/chapter3 and www.fleshandbones.com/genetics/mueller/glossary. Moreover, claim 17 incorporates all limitations of claim 14. Claim 14 requires that the compound (here a polypeptide) "is able to complex specifically with a p53-specific binding site." It is extremely unlikely that a single amino acid could have such ability. Thus claim 17 due to its terms and its functional limitation does not read on the use of a single amino acid and its metes and bounds are clear.

Claim 19 has been amended to delete the phrase "a portion of the monomer sequence" which was objectionable, thus mooting this ground. However, claim 19 was also rejected as unclear in the phrase "sequences adjacent to the monomer sequence in the human genome." The Patent and Trademark Office urges that the phrase could read on both a single nucleotide as well as the whole human genome. Claim 19 has been amended to recite that the compound "comprises an oligonucleotide or oligonucleotide containing nucleotide analogs wherein said oligonucleotide or oligonucleotide containing nucleotide analogs comprises at least one monomer ... as well as sequences adjacent..." An oligonucleotide is defined as a chain of literally, a few nucleic acids. See

www.fleshandbones.com/genetics/mueller/glossary. While an oligonucleotide could comprise at least one monomer plus just one nucleotide of adjacent sequence, it could not include the whole human genome due to the recitation of "an oligonucleotide." The recitation of an oligonucleotide is supported at page 16, line 8 and following.

Claim 20 is also said to be unclear because the phrase "more than one monomer" has no upper limit. The Patent and Trademark Office asserts that the claim could read on an infinite number of monomers. That reading, however, is untenable. The claim recites an "oligonucleotide" which comprises more than one monomer. See definitions above. Since an oligonucleotide does not include within its definition an infinite number of nucleotides, this reading is untenable. Phrases of a claim cannot be read in isolation. Rather, all words of a claim must be given due weight.

Withdrawal of this rejection is requested in view of the amendments and comments provided.

Double Patenting

Claims 14-15, 18-21 and 42 are rejected as obvious over claims 1-22 of U.S. Patent 5,955,263. This rejection is respectfully traversed. The Patent and Trademark Office has previously held the two claim sets to be patentably distinct, and the Patent and Trademark Office is thus precluded by law (35 U.S.C. § 121) from making such a double patenting rejection. "A patent issuing on an application with respect to which a requirement for restriction has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent and Trademark Office or in the courts against a divisional application or against the original application or any patent issued on either one of them, if the divisional application is filed before the issuance of the patent on the other application." Application Serial Nos. 08/299,074 and 07/860,758 presented both original claims 1-13, 28-30, and original claims 14-21. In Restriction Requirements dated September 26, 1996, and April 6, 1993, the Patent and Trademark Office held these claims to be separately patentable. Copies enclosed. Applicants relied on the Patent and Trademark Office's

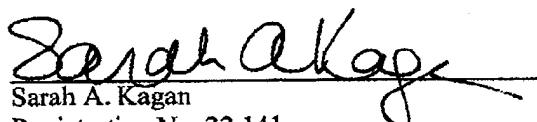
determination in filing the subject divisional patent application. Thus, the Patent and Trademark Office cannot now hold these sets of claims patentably indistinct and reject them for claiming the same invention.

Withdrawal of this invention is respectfully requested. A speedy notice of allowance is requested.

Respectfully submitted,

Date: November 8, 2002

By:


Sarah A. Kagan
Registration No. 32,141

BANNER & WITCOFF, LTD.
1001 G Street, N.W., Eleventh Floor
Washington, D.C. 20001-4597
(202) 508-9100

Customer No. 22907

Appendix – showing amendments in marked-up version

Specification

Substitute paragraph 1 on page 1 of the Preliminary Amendment with the following:

This is a divisional application of U.S. Serial No. 09/399,773, filed September 21, 1999, now U.S. Patent No. 6,245,515, which is a divisional application of U.S. Serial No. 08/299,074, filed September 1, 1994, now U.S. Patent No. 5,955,263 which is a divisional of U.S. Serial No. 07/860,758, filed March 31, 1992, now U.S. Patent No. 5,362,623, which is a Continuation-in-Part of U.S. Serial No. 07/715,182, filed June 14, 1991, now abandoned.

Claims

14. (Amended) A method of providing the physiological effect of wild-type p53 protein to a cell, comprising the step[s] of:

providing to a cell a compound which is [is] able to complex specifically with a p53-specific binding site, whereby the physiological effect of wild-type p53 protein is provided.

18. (Amended) The method of claim 15 wherein the oligonucleotide or oligonucleotide containing nucleotide analogs comprises the monomer sequence RRRCWWGYYY or the complement thereof.

19. (Amended) The method of claim 14 wherein the compound comprises an oligonucleotide or oligonucleotide containing nucleotide analogs wherein said oligonucleotide or oligonucleotide containing nucleotide analogs comprises at least one [a portion of the] monomer sequence RRRCWWGYYY as well as sequences adjacent to said monomer sequence in the human genome.

39. Cancel.